

### **REMARKS**

The Office Action dated January 21, 2010 has been received and carefully noted. Claims 1, 18, 63, and 107-109 have been amended and claims 32-62 and 64-106 have been canceled. No new matter has been added. In view of the foregoing amendments and the following remarks, Applicants respectfully submit that all pending claims are in condition for allowance.

#### **Restriction Requirement**

Applicants have canceled claims 32-62 and 64-106. Applicants reserve the right to file one or more divisional applications directed to the non-elected claims.

#### **Claim Rejection – 35 U.S.C. § 112**

Claims 1 and 107 are rejected under 35 U.S.C. § 112, first paragraph, as being indefinite for failing to comply with the written description requirement. Applicants have amended claims 1 and 107 to obviate the rejection. Withdrawal of this rejection is requested.

#### **Claim Rejections - 35 U.S.C. 102**

Claims 1, 18, 63 and 107-109 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Yoshimune et al. (U.S. Patent No. 6,438,233). Applicants traverse this rejection for at least the following reasons.

Amended claim 1 recites, among other features, a system for transmitting and receiving text, and displaying an indication of the text, wherein the text is transmitted in an electronic signal, the system comprising means for associating subscriber-created data with individual electronic books located in a collection of electronic books, and means for storing the subscriber-created data associated with individual electronic books located in the collection of electronic books in a header file for each of the individual electronic books. Yoshimune fails to disclose at least this combination of features.

On page 6 of the Office Action, the Examiner asserts, with respect to Figures 51-53 of Yoshimune, that "by entering the data on the display screen along with the displayed electronic book that both the displayed electronic book and subscriber-created data are both inherently stored in a display buffer/storage until the user accesses the transmission button to transmit the data back to the central facility/book server." However, Yoshimune does not disclose or suggest means for storing the subscriber-created data associated with individual electronic books located in the collection of electronic books in a header file for each of the individual electronic books, as recited in claim 1. As such, Yoshimune cannot anticipate claim 1.

Independent claims 18, 63, and 107-109 include similar recitations. As such, Yoshimune also fails to anticipate claims 18, 63, and 107-109.

### **Claim Rejections - 35 U.S.C. 103**

Claims 1-2, 7-8, 10-13, 18-19, 22-24, 26-29 and 107-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,093,718 to Hoarty et al. in

view of Kubota (U.S. Patent No. 5,506,902) in further view of Redford et al. (U.S. Patent No. 5,624,265) in further view of Tanigawa et al. (U.S. Patent No. 5,696,928) in further view of Duga et al. (U.S. Patent No. 6, 195, 667). Claims 63 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,093,718 to Hoarty et al. in view of Kubota (U.S. Patent No. 5,506,902) in further view of Redford et al. (U.S. Patent No. 5,624,265) in further view of Tanigawa et al. (U.S. Patent No. 5,696,982) in further view of Duga et al. (U.S. Patent No. 6,195, 667) in further view of Yoshimune et al. (U.S. Patent No. 6,438, 233). Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of Kubota in further view of Redford in further view of U.S. Patent No. 5,210,611 to Yee et al. in further view of Tanigawa et al. (U.S. Patent No. 5,696,982) in further view of Duga et al. (U.S. Patent No. 6,195, 667). Claims 4-5 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of Kubota in further view of Redford in further view of U.S. Patent No. 5,632,022 to Warren et al. in further view of Tanigawa et al. (U.S. Patent No. 5,696,982) in further view of Duga et al. (U.S. Patent No. 6,195, 667). Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of Kubota in further view of Redford in further view of U.S. Patent No. 4,361,848 to Poignet et al. in further view of Tanigawa et al. (U.S. Patent No. 5,696,982) in further view of Duga et al. (U.S. Patent No. 6,195, 667). Claim 9, 14-17, 25 and 30-31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoarty et al. in view of Kubota in further view of Redford in further view of U.S. Patent No. 5,475,399 to Borsuk in further view of Tanigawa et al. (U.S. Patent No. 5,696,982) in further view of Duga et al. (U.S.

Patent No. 6,195, 667). Applicants traverse these rejections for at least the following reasons.

Amended claim 1 recites, among other features, a system for transmitting and receiving text, and displaying an indication of the text, wherein the text is transmitted in an electronic signal, the system comprising means for associating subscriber-created data with individual electronic books located in a collection of electronic books, and means for storing the subscriber-created data associated with individual electronic books located in the collection of electronic books in a header file for each of the individual electronic books. None of the cited references, alone or in combination with each other, disclose or suggest at least this combination of features.

The Examiner correctly admits, on page 11 of the Office Action, that Hoarty, Kubota, and Redford “fail to teach means for storing the subscriber-created data with individual electronic books located in the collection of electronic books,” and relies on Tanigawa to overcome this deficiency. However, Tanigawa fails to disclose or suggest means for storing the subscriber-created data associated with individual electronic books located in the collection of electronic books in a header file for each of the individual electronic books, as recited in claim 1. Duga, which the Examiner relies on for the alleged disclosure of generating a searchable menu of the electronic books in the electronic books collection, does not overcome the deficiencies of Hoarty, Kubota, Redford, and Tanigawa. Accordingly, as none of the cited references, alone or in combination with each other, disclose or suggest at least the above-identified combination of features, Applicants submit that claim 1 is patentable over the cited references.

Independent claims 18, 63, and 107-109 include similar recitations, and are also patentable over the cited references for at least similar reasons to those presented above with respect to claim 1. In addition, all dependent claims are also allowable over the cited references at least by virtue of their dependence on an allowable base claim, as well as for the individual features each claim recites.

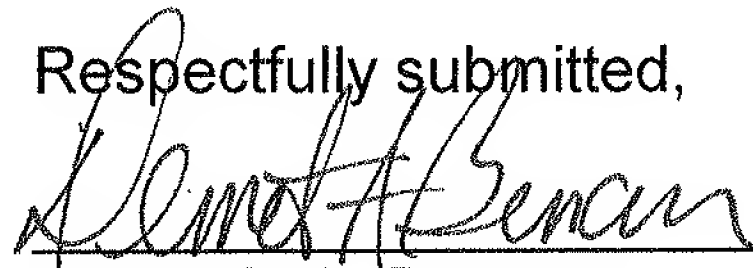
### **Conclusion**

In view of the foregoing, Applicants respectfully request reconsideration of the application, withdrawal of the outstanding rejections, allowance of all pending claims, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing attorney docket number 026880-00013.

Respectfully submitted,

  
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